



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/304,986	09/23/81	NAKAO	H 61552

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EXAMINER	
COUGHLAN, J.	
ART UNIT	PAPER NUMBER
122	10

DATE MAILED: 06/06/83

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 2/18/83 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449 4. Notice of Informal Patent Application, Form PTO-152
5. Information on How to Effect Drawing Changes, PTO-1474 6.

Part II SUMMARY OF ACTION

1. Claims 1-4 + 6-32 are pending in the application.

Of the above, claims 8-17 are withdrawn from consideration.

2. Claims 5 have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-4 + 6-32 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. These drawings are acceptable;
 not acceptable (see explanation).

10. The proposed drawing correction and/or the proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner, disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved, disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections **MUST** be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received
 been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

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Art Unit 122

It is noted that applicants have added dependent claims directed to the pivaloxyloxymethyl ester while base claims 1 and 18 have been amended to exclude this type of ester. It also appears that the only specific compound found in the priority documents that is now under claim 1 is the 1-ethoxycarbonyloxyethyl ester (Example 6 of application no. 136,449/1980) while the declaration of Hideo Nakao relates to other esters.

Claims 7, 21, 22, 25, 28, 29 and 32 are rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Art Unit 122

Claims 1-4, 6, 7, 18, 19, 20, 22-24, 26, 27 and 29-31 are rejected under 35 U.S.C. 103 as being unpatentable over Durckheimer et al, of record. It is again considered that the compounds being claimed are prima facie obvious from the reference while the showings in the declaration are limited to two esters (a and i).

Claims 1-4, 6, 7, 18-20, 22, 24-27, 29, 31 and 32 are rejected under 35 U.S.C. 103 as being unpatentable over Takaya et al (EP 029,557), cited by applicants. The translation of the priority documents only indicates that basis for certain compounds are prior to the date of Takaya et al while various ester forms are indicated on page 22.

Claims 1-4, 6, 7, 18-20, 22, 24-27, 29, 31 and 32 are rejected under 35 U.S.C. 103 as being unpatentable over Heymers et al (EP 034,536), cited by applicants. Basis for various compounds within scope of above claims is not found in priority documents to antedate Heymers et al. It is noted that Heymers et al indicates particularly 1-methoxycarbonyloxyethyl and 1-acetyloxyethyl esters for oral administration while the declaration makes no showings to compare with such esters. Corresponding hydroxyimino compounds are further shown in Examples 2, 39 and 47A.

Coughlan:rt

A/C 703

557-3920

5/18/83

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PRIMARY EXAMINER
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